



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,242	12/09/2005	Richard Joseph Fagan	C&R-101	2652
23557 7590 06/19/2008 SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO BOX 142950 GAINESVILLE, FL 32614-2950				
EXAMINER				
WEN, SHARON X				
ART UNIT		PAPER NUMBER		
1644				
MAIL DATE		DELIVERY MODE		
06/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,242

Applicant(s)

FAGAN ET AL.

Examiner

SHARON WEN

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Applicant's amendment, filed 02/27/2008, has been entered.

Claims 1-72 have been canceled.

Claims 73-94 have been added.

Claims 73-94 are pending and currently under examination as they read on an isolated polypeptide that has alpha-2-macroglobulin-like proteinase inhibitor activity (herein after is referred to as **APIA**) and a pharmaceutical composition comprising the polypeptide.

2. This Action will be in response to Applicant's Arguments/Remarks, filed 03/18/2008.

The rejections of record can be found in the previous Office Action.

Claim Rejections - 35 USC § 112 second paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 73-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 73-94 are indefinite in the recitation of "alpha-2-macroglobulin-like proteinase inhibitor *activity*" because said "*activity*" is not clearly defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the invention or the parameters by which to determine said metes and bounds. Applicant is invited to consider amending the claims to recite the particular characteristics of said "*activity*" intended by setting forth testable functions, provided there is written description in the specification as-filed.

Applicant is reminded that any amendment must point to a basis in the specification so as not to add New Matter. See MPEP 714.02 and 2163.06.

Claim Rejections - 35 USC § 112 first paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Newly added claims 73-94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description** requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's argument has been considered in full but not found persuasive for the following reasons.

Regarding the instant claim limitations, the specification does not appear to provide an adequate written description for:

- 1) a genus of polypeptides that have at least 85% identity to SEQ ID NO: 68, and
- 2) a genus of polypeptides that have at least 95% identity to SEQ ID NO: 70 or 72.

In response to Applicant's assertion that the newly added claims now meet the written description requirement because they now recite a function for the polypeptide, i.e., APIA, the following is noted.

The Guidelines for the Examination of Patent Applications Under the 35 U.S.C § 112, paragraph 1 "Written Description" requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics coupled with a known or disclosed correlation between function and structure, or by a

Art Unit: 1644

combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4 pages 1099-1111, Friday January, 2001, See especially page 1106 3rd column).

The problem here is that the newly added claims required the polypeptides to have the property of APIA. However, there is insufficient written description to lead a person of skill in the art to know, regarding the variants polypeptides encompassed by the above mentioned genus, which sequences are essential, which sequences are non-essential for having APIA.

The fact that two polypeptides that are homologous in structure or share certain degrees of identity in sequence does not in and of itself required that the two sequences share any functional activity such as APIA, a feature deemed essential for the claimed polypeptide.

For example, Attwood (reference of record, Science 2000; 290:471-473) teaches that "[i]t is presumptuous to make functional assignments merely on the basis of some degree of similarity between sequences. Similarly, Skolnick et al. (reference of record, Trends in Biotech. 2000; 18(1):34-39) teach that the skilled artisan is well aware that assigning functional activities for any particular protein or protein family based upon sequence homology is inaccurate, in part because of the multifunctional nature of proteins (e.g., "Abstract" and "Sequence-based approaches to function prediction", page 34). Even in situations where there is some confidence of a similar overall structure between two proteins, only experimental research can confirm the artisan's best guess as to the function of the structurally related protein (see in particular "Abstract" and Box 2).

Applicant's arguments have been fully considered but not found convincing. Therefore, the rejection is maintained for the reasons of record as it applies to newly added claims. The rejection is incorporated by reference herein, as if reiterated in full.

7. The previous **enablement** rejection under 35 USC 112 first paragraph regarding "vaccine" has been withdrawn in view of Applicant's amendment, filed 02/27/2008.

Claim Rejections - 35 USC § 102

8. The previous rejections under 35 USC 102(a) as being **anticipated** by Keduda et al. has been withdrawn in view of Applicant's amendment, filed 02/27/2008.
9. The previous rejections under 35 USC 102(a)(e) as being **anticipated** by Rosen et al. has been withdrawn in view of Applicant's amendment, filed 02/27/2008.

Conclusion

10. No claim is allowed.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON WEN whose telephone number is (571)270-3064. The examiner can normally be reached on Monday-Thursday, 8:30AM-6:00PM, ALT. Friday, EST.

Art Unit: 1644

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara can be reached on (571)272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharon Wen, Ph.D./

Examiner, Art Unit 1644

June 18, 2008

/Phillip Gambel/

Phillip Gambel, Ph.D., J.D.

Primary Examiner

Art Unit 1644

Technology Center 1600

June 18, 2008